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10/668,094	09/22/2003	Zvi Orbach	154682-0004	4664
29000	7590	09/15/2005	EXAMINER	
IRELL & MANELLA LLP 1800 AVENUE OF THE STARS SUITE 900 LOS ANGELES, CA 90067			FISCHER, ANDREW J	
			ART UNIT	PAPER NUMBER
			3627	

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/668,094

Applicant(s)

ORBACH ET AL.

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-76 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-76 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### *Acknowledgements*

1. This combined Office Action is result of the "Decision Merging Reexamination and Reissue Proceedings" ("First Merger Decision") mailed by the USPTO on March 25, 2005. Applicant is reminded that his response to this Office Action must also comply with the First Merger Decision. For additional guidance, see §MPEP 2285.
2. The finality from the previous Office Action (mailed March 24, 2003 in 09/006,197) is hereby withdrawn.
3. All references in this Office Action to the capitalized versions of "Applicant," "Patent Owner", or "Assignee" refers specifically the Applicant, Patent Owner, or Assignee of record. References to lower case versions of applicant, patent owner, or assignee refers to any or all applicant(s), patent owner(s), or assignee(s). For simplicity purposes, the Examiner will refer to the Applicant, Patent Owner, or Assignee in this Office Action only as Applicant. Unless expressly noted otherwise , references to "Examiner" in this Office Action refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally.
4. Formal requirements (e.g. proper oaths and/or declarations) are waived by the Examiner for this Office Action only.

### *Specification*

5. The amendment to the specification filed April 27, 2005 in the Housekeeping Amendment is objected to under 35 U.S.C. §132(a) because it introduces new matter into the disclosure. 35 U.S.C. §132(a) states that no amendment shall introduce new matter into the

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disclosure of the invention. The added material which is not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action. The replacement abstract filed April 27, 2005 in the Housekeeping Amendment has been approved by the Examiner.

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), MPEP §608.01(o), and MPEP §2181. The claims are replete with these errors. The Examiner highly recommends Applicant review all pending claims to ensure that each 'mean plus function' phrase has proper antecedent basis. Correction of the following is required:

- i. The "means for embedding" as recited in claim 19.
- ii. The "means for locating" as recited in claim 55.
- iii. The "means for enabling" as recited in claim 55.

***Claim Rejections - 35 USC §101***

7. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claim 76 is indefinite because it is unclear which of the four (4) statutory classes the claim is drawn too. "Software" is not one of the four statutory classes. If Applicant expressly states which of the four (4) statutory classes this claim is drawn to, this particular §101 rejection will be withdrawn.

***Claim Rejections - 35 USC §112 2<sup>nd</sup> Paragraph***

9. The following is a quotation of the 2<sup>nd</sup> paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-76 are rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claims 1 and 37, it is unclear how in a system claim, a function (*i.e.* “associating”) can comprise structure (*i.e.* the corresponding structure in the “means for embedding”). It seems logical that only structure can further comprise additional structure.
- b. In claim 19, it is unclear what the corresponding structure in the “means for providing copy protection . . . .”
- c. Claim 76 is indefinite because it is not known if the claim is limited to only software or steps or structure outside the scope of ‘software’ since the claim recites “in response to the selection input entered by the customer.”
- d. In claim 53, it is unclear what the corresponding structure in the “means for locating . . . .”
- e. In claim 54, it is unclear what the corresponding structure in the “means for enabling . . . .”
- f. In claim 55, it is unclear what the corresponding structure in the “means for receiving . . . .”

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g. In claim 55, it is unclear what the corresponding structure in the “means for . . . dispensing . . . .”

h. In claim 58, it is unclear if the memory is “in” or “at” the point of sale terminal.” It is the Examiner’s position that issued claim 1 recites four (4) separate and independent elements of the “automated merchandising system.

i. In claim 71, it is unclear what the corresponding structure in the “means for causing the printer to print sales records . . . .”

j. In claim 74, it is unclear what the corresponding structure in the “means for dispensing . . . .”

k. Also in claim 74, it is unclear if the “means for dispensing” is the same or different from the “means for . . . dispensing” as recited in 55.

11. The Examiner finds that because claims 1-76 are indefinite under 35 U.S.C. §112 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. See *Honeywell International Inc. v. ITC*, 68 USPQ2d 1023, 1030 (Fed. Cir. 2003) (“Because the claims are indefinite, the claims, by definition, cannot be construed.”). However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claim are indefinite, the claims are construed and the art is applied *as much as practically possible*.

### ***Reissue***

12. Claims 1-76 are rejected under 35 U.S.C. §251 as being improperly broadened in a reissue application made and sworn to by the assignee and not the patentee. A claim is broader in

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scope than the original claims if it contains within its scope any conceivable product or process which would have infringed the original patent. A claim is broadened if it is broader in any one respect even though it may be narrower in other respects.

13. Because many of the claims are new claims and in reference to the statements below, where the Examiner states that the claim ‘no longer recites [x]’ or similar language, this ‘no longer recites’ is in reference to the *issued claims*.

14. In claims 1 and 19, Applicants has removed the corresponding structure in the “means for associating” from the issued claims.

15. In claim 55, the claim no longer recites a separate “means for associating” which was independent of the “point of sale terminal.”

16. In claim 37, Applicant has removed the “means for associating comprises means for embedding . . . .” Although there only appears to be the replacement of “comprising” with “including,” it is the Examiner’s position that change removes the “means for associating” from a 35 U.S.C. §112 6<sup>th</sup> paragraph interpretation. However, if Applicant expressly states on the record that “including” is synonymous with comprising and provides appropriate evidence in support thereof, this particular rejection (*i.e.* with respect to claim 37) will be withdrawn. Such a statement would be construed to retain the application of 35 U.S.C. §112 6<sup>th</sup> paragraph to the phrase “wherein said means for associating includes means for embedding . . . .”

17. In claim 57, the claim no longer recites the “means for writing software selected . . . .”

***Claim Rejections - 35 USC § 102***

18. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

19. Claims 1-10, 12, 13, 15, 16, 19-28, 30, 31, 33, 34, 37-46, 48, 49, 51, and 52-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Freeny, Jr. (U.S. 4,528,643) ("Freeny"). Freeny discloses the following: memory (within 86) located at the point of sale ("POS") terminal(s) (14 is a part of the POS); the POS terminal(s) including customer interface means for receiving a software select customer choice input (a keyboard); means for writing software (24, includes a standard diskette drive and the head doing the actual writing of the software, see also column 21, lines 20-21; 24 could also be printers, see column 22, lines 46-47) selected by a customer from the memory onto a software carrier (floppy disk); means for associating an identification code (owner codes, catalog reproduce code, or catalog transmit code) with software provided to a customer, the means for associating comprises means for embedding said identification code on the software (within 24); the identification code comprises purchaser identification; the memory may be at a local or remote location or at the POS terminal (12 may be a local or remote location then transferred to memory at the POS terminal before written to the medium); means identifying means of payment (program code embedded with 110); means for preventing copying (owner codes, decipher program, etc); the memory may be remote from the POS terminal and connected with a modem (88); the standard diskette drive inherently includes means for dispensing (how else would the diskette be removed?); a sales receipt is a



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sales report in hard copy including date of purchase on the sales receipt; the monitor, memory, and program embedded within the memory generate and display a menu; and the system is capable of allowing the customer to operate the software (the computers are general purpose computers); means for providing a potential customer the opportunity for operating the software prior to a decision to purchase (the object itself such as music playing the retail establishment; alternatively takes the object home and never purchases the software or music but merely retains a license to use the software or music).

***Claim Rejections - 35 USC §103***

20. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claims 11, 29 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeny in view of Nitatori et. al. (U.S. 5,046,042) ("Nitatori"). Freeny discloses as discussed above and directly discloses among other things floppy disks, phonograph records and video disks to store data (column 5, lines 45-59). Freeny does not directly disclose CD-ROMs to store data. Nitatori however discloses the general use of CD-ROMs to store data. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Freeny as taught by Nitatori to include CD-ROMs to store data. Such a modification would have allowed for more efficient storage of data.

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22. As stated in the previous office actions,<sup>1</sup> it is the Examiner maintains his position that “CD-ROMs” and floppy disks are “art recognized equivalents.” See MPEP §2144.

23. Claims 14, 17, 18, 32, 35, 36, 50, 53, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeny in view of Scarbrough (U.S. 4,314,356)(“Scarborough”). Freeny discloses as discussed above but does not directly disclose a key word search. Scarborough teaches a key word search to search predetermined words or terms.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Freeny as taught by Scarborough to include key word search means enabling a potential purchaser to search available programs via key words in their names and descriptions. Because this is a digital computer, one of ordinary skill in the art could clearly implement a key word searching system in Freeny. Such a modification would have provided a faster way of searching for the desired information.

Again, although functional limitations are clearly acceptable,<sup>2</sup> if the prior art is capable of performing the claimed function—even if not directly disclosed—it anticipates. *In re Schreiber*, 128 F.3d 1473, 1478, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997) (applicant’s popcorn dispenser was rejected with an oil can because the functional limitations were inherent in the reference).

24. In summary, the Examiner notes that if the claim recites only ‘capable of’ language, the prior art need only be ‘capable of’ to anticipate. See *Schreiber* above. On the other hand, if the

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<sup>1</sup> See the Examiner’s previous Office Action, Paper No. 10, Paragraph No. 13 mailed October 30, 2002; and the Office Action March 24, 2003, Page 8, Paragraph No. 12.

<sup>2</sup> See *In re Swinehart*, 439 F.2d 210, 212, 169 USPQ 226, 228 (CCPA 1971).

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claim *actually recites* a positive action, the prior art too must actually perform that action to anticipate. However our case is the former. In other words, because Patent Owner's claims only recite 'capable of' language, the prior art need only be 'capable of' performing the claimed functions.

25. The Examiner maintains his position that Applicant is not his own lexicographer.

26. The Examiner incorporates by reference the "35 U.S.C. 112 6<sup>th</sup> Paragraph" analysis as noted in the Office Action in March 23, 2003, beginning on page 10.

### ***Conclusion***

27. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8<sup>th</sup> Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8<sup>th</sup> Edition, August 2001.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Fischer whose telephone number is (571) 272-6779.

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30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Andrew J Fischer  
Primary Examiner  
Art Unit 3627

AJF  
September 12, 2005